

09-17-04

2132

Application No.: 09/632,944

Final Notice Regarding Related Litigation

PATENT 41

Customer No. 22,852

Attorney Docket No. 7451.0004-02

InterTrust Ref. No.: IT-6.1.1 (US)



**CERTIFICATE OF EXPRESS MAILING**  
I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office to Addressee" service under 37 CFR § 1.10, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 15, 2004. Express Mail Label No.: EV533069764US  
Signed: Athena E. Pretory  
Athena E. Pretory

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SEP 20 2004

Technology Center 2100

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
)  
Karl L. GINTER et al. ) Group Art Unit: 2132  
)  
Application No.: 09/632,944 ) Examiner: DARROW, Justin T.  
)  
Filed: August 4, 2000 )  
)  
For: TRUSTED AND SECURE ) Confirmation No.: 2078  
TECHNIQUES, SYSTEMS AND )  
METHODS FOR ITEM DELIVERY )  
AND EXECUTION )  
)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Sir:

**FINAL NOTICE REGARDING RELATED LITIGATION**

Applicants submit this Final Updated Notice to inform the Examiner of the status of the litigation between InterTrust and Microsoft, captioned InterTrust Technology Corp. v. Microsoft Corp. (C 01-1640 SBA, N. D. Ca.), in fulfillment of their duty to disclose information potentially material to patentability under 37 CFR §§1.56 and 1.97. This paper is being filed before the mailing date of a first Office Action on the merits for the above-referenced application.

This paper is entitled "Final Notice" because this litigation has been dismissed with prejudice following settlement of the dispute. The present application, Application

No. 09/632,944, is a continuation of U.S. Application No. 09/221,479, which issued as U.S. Patent No. 6,185,683 (one of the patents asserted in the litigation<sup>1</sup>). This application and/or its ancestor applications may also be related to the patents in suit by 1) incorporating by reference the patents in suit and/or applications leading to the patents in suit; 2) containing statements that their subject matter may bear relation to the patents in suit and/or applications leading to the patents in suit; and/or 3) claiming the benefit of priority of common applications.

### **STATUS OF RELATED LITIGATION**

The final status of the litigation is as follows. On September 2, 2003, InterTrust filed InterTrust's Disclosures of Asserted Claims and Preliminary Infringement Contentions Pursuant to Patent Local Rules 3-1 and 3-2, including Exhibits (A-C<sup>2</sup>). See Tab 1. Exhibits 1A and 1B are submitted herewith. Exhibit 1C has not been provided because (1) it is marked "Confidential - Subject to Protective Order" and "Attorneys Eyes Only" (as it pertains to proprietary Microsoft information); and (2) it is not material to the patentability of the pending claims, as it contains only information pertaining to Microsoft's current products and systems.

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<sup>1</sup> The following is a list of all patents asserted: 6,389,402, 6,253,193, 6,185,683, 6,157,721, 6,112,181, 5,982,891, 5,949,876, 5,940,504, 5,920,861, 5,917,912, 5,915,019, and 5,892,900.

<sup>2</sup> To distinguish between sub-exhibits of tabs referred to in this paper, Applicants will hereinafter prefix each sub-exhibit with its corresponding tab (e.g., Exhibits A-C of Tab 1 will be referred to as Exhibits 1A-1C).

On November 17, 2003, Microsoft filed Defendant Microsoft Corporation's Preliminary Invalidity Contentions (Patent Local Rules 3-3 and 3-4). See Tab 2, including Exhibits 2A-2C.<sup>3</sup>

On February 23, 2004, Microsoft filed a Notice of Motion and Memorandum in Support of Motion for Partial Summary Judgment of Invalidity of the Asserted Claims of the '900 Patent (Anticipation). See Tab 3.

On February 23, 2004, Microsoft also filed a Notice of Motion, Motion and Memorandum in Support of it's Motion for Partial Summary Judgment of Invalidity of the Asserted Claims of the '181 Patent (Anticipation). See Tab 4.

The parties subsequently settled and, on May 5, 2004, filed a Joint Stipulation of Dismissal with Prejudice. See Tab 5.

Tab 6 is a copy of the press release announcing the settlement and indicating that Microsoft has taken a comprehensive license to InterTrust's patent portfolio for a one-time payment of \$440 million.

### **REMARKS**

Applicants encourage the Examiner to carefully review the attached documents, and let Applicants know if any additional information is desired.

With this Notice, Applicants have provided copies of the papers described in the Status of Related Litigation section above. Furthermore, a voluminous number of documents have been referred to in the Microsoft paper attached as Tab 2 (specifically, in Exhibit 2A, attached thereto), many of which are already of record before the Office.

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<sup>3</sup> *Id.*

References listed in Exhibit 2A which have not already been cited in this application are being submitted in an Information Disclosure Statement to be filed shortly in this case. Furthermore, Exhibits 2B and 2C<sup>4</sup> to Microsoft's Preliminary Invalidity Contentions, which comprise an extensive listing of claim charts pertaining to the patents-in-suit, are provided along with a summary of the claims addressed. This summary should help the Examiner determine which, if any, of the prior art claim charts of Exhibits 2B and 2C should be reviewed by the Office (for example, Exhibit 2C contains § 112 indefiniteness charts relating only to the claims of the patents in suit).

With this Notice, Applicants have provided copies of some of the exhibits referred to in the provided papers. However, due to the large quantity of documents referenced by these papers, all attachments and exhibits have not been provided. For example, the exhibits to the motions provided at Tabs 3 and 4 are not provided because they have inconsequential, if any, relation to the patentability of the instant claims. These exhibits are not necessary to understand the motion, and are not relevant to the Office's review (e.g., they are directed to issues specific to the '900 patent, they pertain to Microsoft's products, they contain Microsoft's Attorneys-Eyes-Only information that we cannot disclose, etc.).

As always, if the Examiner believes that any document referred to in these papers and not yet submitted may be helpful in resolving an issue before him and would like to review that or any other document, Applicants invite the Examiner to contact the undersigned at (650) 849-6643 so we may provide such document.

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<sup>4</sup> Exhibits 1B and 1C are provided in electronic format via CD-ROM due to their length.


Applicants submit this Notice Regarding Related Litigation in fulfillment of their duty to disclose information potentially material to patentability under 37 C.F.R. 1.56. This submission does not constitute an admission that any of the listed documents are material or constitute "prior art."

If there are any fees due with the filing of this Notice which have not yet been paid, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 15, 2004

By:   
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### TABLE OF EXHIBITS

Tab	Description	Date
1.	InterTrust Disclosures of Asserted Claims and Preliminary Infringement Contentions Pursuant to Patent Local Rules 3-1 & 3-2, including Exhibits A-C	9/2/03
2.	Microsoft Preliminary Invalidity Contentions (Patent Local Rules 3-3 and 3-4), including Exhibits A-C	11/17/03
3.	Microsoft Motion and Memorandum in Support of Motion for Partial Summary Judgment of Invalidity of the Asserted Claims of the '900 Patent	2/23/04
4.	Microsoft Motion and Memorandum in Support of it's Motion for Partial Summary Judgment of Invalidity of the Asserted Claims of the '181 Patent	2/23/04
5.	Joint Stipulation of Dismissal with Prejudice	5/5/04
6.	Press Release Announcing Settlement	4/12/04

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